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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,500	11/21/2001	John L. Wasula	79564APRC	3356

7590 03/29/2010
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EXAMINER

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ART UNIT	PAPER NUMBER
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2622

MAIL DATE	DELIVERY MODE
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03/29/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN L. WASULA and ANTHONY L. TINTERA

Appeal 2009-003811
Application 09/990,500
Technology Center 2600

Decided: March 29, 2010

Before JOSEPH F. RUGGIERO, THOMAS S. HAHN, and ELENI
MANTIS MERCADER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-5, 8, 9, 11-25, and 27-32. Claims 6, 7, 10, and 26 have been indicated by the Examiner (Ans. 17) to be allowable if rewritten in independent form. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed June 2, 2006) and the Answer (mailed February 14, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to a digital camera for capturing and organizing digital images for subsequent transfer to an external device. The digital camera includes a database having a plurality of user selectable customized profiles with each customized profile including a plurality of image utilization fields. (*See generally* Spec. 3:21-25, 5:18-28, and 6:24-29).

Claim 1 is illustrative of the invention and is reproduced as follows:

1. A digital camera for capturing digital images and organizing the captured images for subsequent transfer from the digital camera to an external device that utilizes the digital images, comprising:

(a) means for providing a database having a plurality of customized profiles, wherein each customized profile contains a plurality of image utilization fields, the image utilization fields identifying respective instructions for utilization of one or more digital images by the external device;

(b) means for selecting one of the plurality of customized profiles

from the database;

(c) means for defining a plurality of profile indices respectively corresponding to ones of the plurality of customized profiles;

(d) an image sensor for capturing images;

(e) means for associating a profile index with at least one captured image to identify the corresponding selected customized profile; and

(f) storage means for receiving and storing the at least one captured image and the corresponding profile index.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Kuba	US 5,806,072	Sep. 8, 1998 (filed Dec. 21, 1992)
Safai (Safai '469)	US 6,167,469	Dec. 26, 2000 (filed May 18, 1998)
Anderson	US 6,177,956 B1	Jan. 23, 2001 (filed Oct. 23, 1996)
Steinberg	US 6,433,818 B1	Aug. 13, 2002 (filed Jul. 15, 1999)
Roberts	US 6,496,222 B1	Dec. 17, 2002 (eff. filed Feb. 19, 1999)
Safai (Safai '361)	US 2003/0048361 A1	Mar. 13, 2003 (eff. filed May 29, 1998)

Comment [k1]: Nov. 27, 2000

Comment [k2]: Jun. 19, 2002

Comment [jtr3]: The "effective" filing date is needed to antedate Appellants effective filing date of 06/02/99.

Claims 1-5, 8, 11, and 16-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Safai '469.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Safai '469 in view of Safai '361.

Claims 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuba in view of Roberts.

Claims 9 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Safai '469 in view of Steinberg.

Claims 21-24 and 27-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Safai '469 in view of Kuba.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Safai '469 in view of Kuba and Roberts.

ISSUES

The pivotal issues before us are whether the Examiner erred in determining that:

- a) Safai '469 discloses
 - i) a digital camera with a database that includes selectable customized profiles having image utilization fields along with a corresponding profile index to identify a selected profile, and
 - ii) the customized profiles having image utilization fields which identify instructions on how images are to be handled by an external device;
- b) Roberts discloses
 - i) the storing of a plurality of software application program identifiers which identify programs that are resident on an external device and which can be selected to be associated with a captured image, and
 - ii) if so, the obviousness to the ordinarily skilled artisan of combining Roberts with the digital camera teachings of Kuba and/or Safai '469.
- c) Steinberg discloses

- i) the selection of a user code for permitting access to selected customized profiles, and
- ii) if so, the obviousness to the ordinarily skilled artisan of combining Steinberg with the digital camera teachings of Safai '469; and
- d) the obviousness to the ordinarily skilled artisan of combining the memory card teachings of Kuba with Safai '469 and Roberts.

FINDINGS OF FACT

The record supports the following relevant findings of fact (FF) by a preponderance of the evidence:

1. Safai '469 discloses (Figs. 1 and 2, col. 5, ll. 37-39, col. 8, ll. 61-67, and col. 12, ll. 36-49) a digital camera for capturing digital images and transferring the images to an external device that utilizes the images.
2. Safai '469 further discloses (Fig. 4F, col. 12, ll. 37-60) the organizing of captured images for transfer including a Send Message Screen 454 which includes an address field 466, a photo field 468, a voice message check box 470, and a Store button 476.
3. The example depicted in the Figure 4F Message Screen illustration of Safai '469 shows the association of selected photos in the "Photo" field 468 with an e-mail address in the "To" address field 466, a message in the checked "Voice Message" box 470, and the Delete Pictures after Sending box 472.
4. When the Store button 476 is activated, Safai '469 discloses (col. 12, l. 61-col. 13, l. 6) that photo, address, and message information is

stored in an Out Box which contains a list of messages configured for transmission to an external device.

5. Safai '361 discloses (§ [0065]) a digital camera that utilizes a memory card in the form of a flash EPROM.

6. Roberts discloses (Figs. 2A, 6, and 14A; col. 8, ll. 30-65 and col. 12, ll. 9-41) a user activation of a format switch 17 to select proper formatting, i.e., IBM or Apple, for images transferred to an external device.

7. Steinberg discloses (col. 2, ll. 39-43 and col. 9, ll. 14-17) the requirement of an entered password to access a set of stored images in a digital camera.

8. Kuba discloses (Fig. 2, col. 14, ll. 57-61) the storing of customized image files in a removable memory card of a digital camera.

PRINCIPLES OF LAW ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a

finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(e) REJECTION

Appellants' arguments initially focus on the contention that, in contrast to the invention set forth in independent claims 1, 16, and 17, the digital camera described by the Safai '469 reference does not include a disclosure of a customized profile with a corresponding profile index and which is selectable from a plurality of customized profiles. According to Appellants (App. Br. 9-11), while Safai '469 discloses the storing of a list of messages which are associated with photos and an e-mail address in an Out Box, the messages have been finalized for transmission and cannot be modified. In Appellants' view, the procedure described by Safai '469 only permits a user to resume the transport of a previously finalized message, but does not allow a user to associate with the stored messages those images captured subsequent to the generation of the messages.

We find, however, that Appellants' arguments are not commensurate with the scope of the language of independent claims 1, 16, and 17. To whatever extent Appellants may be correct that a user in Safai '469 can not associate subsequently taken images with a previously created profile or edit a previously created profile, no such requirements appear in the claims. As pointed out by the Examiner (Ans. 20), even if the list of messages stored in the Out Box in Safai '469 are finalized messages, this does not preclude them from being considered customized profiles as claimed.

With the above discussion in mind, we find no error in the Examiner's conclusion (Ans. 4-5) that the illustration in Figure 4F of Safai '469 represents a customized profile which associates particular photos 468 with messages 470. (FF 2). Similarly, we find no error in the Examiner's conclusion (Ans. 7) that Safai '469 provides for the selection of particular ones of the customized profiles for use with one or more stored images by,

for example, providing for the selection of certain photos (Fig. 4F, photos 1, 4) for deletion after sending. (FF 3). We further agree with the Examiner's conclusion that Figure 4F of Safai '469 includes an index in the form of the "To" address field 466 which references the message to be sent and is associated with the "Photo" field 468 and, as such, corresponds to what is claimed. (FF 3 and 4).

We further find unpersuasive Appellants' contention that Safai '469 fails to disclose customized profiles in which the image utilization fields identify instructions on how images are to be handled by an external device. According to Appellants (App. Br. 9-12), the fields in the Send Message Screen 454 of Safai '469 provide instructions to the digital camera and not to any external device.

We agree with the Examiner's conclusion, however, that the fields 466, 468, 470, and 472 depicted in the Figure 4 F illustration of Safai' 469 represent instructions to an external device. (FF 3 and 4). For all of the reasons explained by the Examiner (Ans. 19), we fail to see why instructions as to what e-mail account images are to be stored (field 466) and to which photo images an associated voice message is to be played (fields 468 and 470) would not be considered instructions to an external device as claimed.

In view of the above discussion, we find that the Examiner did not err in concluding that all of the claimed limitations are present in the disclosure of Safai '469. Accordingly, the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 16, and 17, as well as dependent claims 2-5, 8, 18, and 19 not separately argued by Appellants, is sustained.

35 U.S.C. § 103(a) REJECTIONS

Dependent claim 12

The Examiner's obviousness rejection of dependent claim 12 based on the combination of Safai '469 and Safai '361 is sustained as well. We find no error in the Examiner's application (Ans. 9) of the flash EPROM memory card teachings (FF 5) of Safai '361 to the digital camera system disclosed by Safai '469. Appellants' arguments (App. Br. 19) rely on the arguments asserted previously against independent claims 1, 16, and 17, which arguments we have found to be unpersuasive for all of the previously discussed reasons.

Claims 13-15

We also sustain the Examiner's obviousness rejection, based on the combination of Kuba and Roberts, of claims 13-15. Appellants' arguments attack the Examiner's reliance on Roberts as providing a teaching of storing a plurality of software application program identifiers which identify programs that are resident on an external device and which can be selected to be associated with a captured image. According to Appellants (App. Br. 17) the codes in the format field 57 of the data diskette 50 of Roberts identify different computer architectures, i.e., IBM or Apple, not software application programs.

We agree with the Examiner (Ans. 11 and 21), however, that Roberts' disclosure (FF 6) of user activation of a format switch 17 to select proper formatting, i.e., IBM or Apple, for an external device corresponds to the claimed selection of a plurality of software program identifiers that are associated with a captured image. We also agree with the Examiner that an ordinarily skilled artisan would have recognized and appreciated that each of

the IBM and Apple computer architectures contains a plurality of software application programs so that the activation of the format switch 17 in Roberts will identify a plurality of these programs as claimed. Lastly, Appellants' arguments to the contrary notwithstanding, we find that the Examiner (Ans. 11) has set forth a valid articulated line of reasoning with a rational underpinning to support the legal conclusion of obviousness for combining the teachings of Kuba and Roberts.

Claims 9 and 20

Appellants' arguments focus on the alleged deficiency of Steinberg in disclosing the selection of a user code for permitting access to selected customized profiles. According to Appellants (App. Br. 18-19), Steinberg's code entering procedures for authorizing access apply to granting access to the entire camera, and not to a particular selected custom profile as claimed.

We agree with the Examiner (Ans. 21-22), however, that Appellants' arguments unpersuasively attack the individual differences between Steinberg and the claimed invention when the rejection is based on the *combination* of Safai '469 and Steinberg. As explained by the Examiner (Ans. 12-14), the teaching of providing user selection of one of a plurality particular customized profiles from a database is provided by Safai '469. Steinberg is relied upon only for a teaching (FF 7) of requiring an entered password to access a set of stored images in a digital camera.

Further, contrary to Appellants' related argument (App. Br. 19), the Examiner (Ans. 13-14) has provided an articulated line of reasoning with a rational underpinning to support the conclusion that the addition of a password authorization feature to access the selected customized profiles would have served as an obvious enhancement to the system of Safai '469.

Accordingly, the Examiner's obviousness rejection of claims 9 and 20, based on the combination of Safai '469 and Steinberg is sustained.

Claims 21-24 and 27-32

We also sustain the Examiner's obviousness rejection, based on the combination of Safai' 469 and Kuba, of claims 21-24 and 27-32. We find no error in the Examiner's conclusion (Ans. 14) that images transferred to the external device in Safai '469 would be modified by having an attached voice message, and would be located in a directory defined by an e-mail address entered in the "To" address field 468 as illustrated in Figure 4F. Further, with respect to Appellants' particular remarks (App. Br. 20-21) regarding claim 23, we agree with the Examiner that the claim language does not require that editing of the customized profile be performed by the external device. Rather, the claim language requires only that editing is, or has been, performed on the customized profile which has been transferred to the external device, a feature taught by Safai '469 as previously discussed.

We further find no error in the Examiner's conclusion (Ans. 15) that an ordinarily skilled artisan would have recognized and appreciated that Kuba's teaching (FF 8) of storing customized image files in a removable memory card would have obvious application to the device of Safai '469 for, inter alia, enabling a user to display images on another camera or external device if a user's original camera becomes inoperative.

Claim 25

The Examiner's obviousness rejection, based on the combination of Safai '469, Kuba, and Roberts is also sustained. We find no error in the

Examiner's application (Ans. 17) of the software application identifier feature of Roberts to the system of '469 as modified by Kuba. Appellants reiterate their arguments (App. Br. 21-22) made with respect to previously discussed claims 13-15 regarding the alleged deficiency of Roberts in disclosing the claimed software application identification feature, which arguments we have found to be unpersuasive.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-5, 8, 11, and 16-19 for anticipation under 35 U.S.C. § 102(e), nor in rejecting claims 9, 12-15, 20-25, and 27-32 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 1-5, 8, 11, and 16-19 under 35 U.S.C. § 102(e) and claims 9, 12-15, 20-25, and 27-32 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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